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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Applicant:

AUGUST H. BECK, III

Filed: June 18, 1999

Serial No.: 09/336,204

Title: PILOTED DRILL BARREL AND
METHOD OF USING SAME

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Art Unit: 3671

Examiner: Nathan S. Mammen

Docket No.: 063007.0010

**APPEAL BRIEF**

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| A. CLAIMS ON APPEAL                            |             |
| B. Mason (US Patent No. 4,165,130)             |             |

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APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
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Dear Sir:

Appellant August H. Beck, III (also referred to as "Applicant") submits in triplicate his Appeal Brief from the Final Rejection dated June 13, 2003. Timely Notice of Appeal is being filed concurrently herewith. A check in the amount of \$165.00 for filing an appeal brief is enclosed herewith. The Commissioner is hereby authorized to charge any additional fees which may be required or credit overpayment to Deposit Account No. 01-0477.

I.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by this Board's decision in the present appeal.

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## **II.**

### **STATUS OF THE CLAIMS**

Claims 1-41 are pending in the present application. Claims 1-22 and 26-41 are allowed. Independent Claim 23 and its dependent Claim 25 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,165,130 to Mason. Claim 24 was objected to as being dependent on rejected Claim 23. Claims 23 – 25 are set forth in their present form in Appendix A to this Brief.

## **III.**

### **STATUS OF AMENDMENTS**

Applicant requested the cancellation of Claim 24 and presented that claim, rewritten in independent form as new claim 42, in an amendment filed November 20, 2003. In a paper mailed December 16, 2003, the examiner refused to enter the amendment due to the presence of typographical errors in claim 42 as presented.

## **IV.**

### **SUMMARY OF THE INVENTION OF CLAIM 23**

In one embodiment according to the present invention of Claim 23, there is provided a drilling apparatus that makes use of downhole hammers and is suitable for drilling large diameter shafts for building foundations and the like. The salient features of a preferred embodiment are shown in Figs. 1, 4 and 11, including a drill barrel 4 having peripherally disposed pneumatic hammer drills 12. The proximal end (opposite the cutting end) of Applicant's drilling apparatus is substantially open (Figures 1 and 4) for receiving excavated cuttings 64 after they are blown upward between the barrel's exterior and the wall of the shaft by air exhausted from the hammer drills, and then fall back down under the influence of gravity. The barrel may be provided (as in claim 24) with a releasable hatch at its distal end, through which collected cuttings may be

removed when the barrel is withdrawn. (Page 7, line 20 – Page 8, line 1). In a particularly preferred embodiment, the barrel has a diameter of at least about 36 inches (claim 25).

V.

**ISSUE ON APPEAL**

Whether claims 23 and 25 are anticipated under 35 U.S.C. § 102(b) by Mason '130. More particularly, whether Mason's drill barrel is "substantially hollow and substantially open at its proximal end" for receiving and collecting cuttings during the drilling process.

VI.

**GROUPING OF THE CLAIMS**

Claim 25 does not stand or fall together with claim 23. Claim 25 depends from claim 24, which was indicated to be allowable if rewritten to incorporate the limitations of base claim 23. Perhaps due to an oversight, the examiner appears to have rejected claim 25 in the belief that it depends directly from claim 23. Because claim 25 depends instead from claim 24, Appellant submits that claim 25 is patentable for the same reasons that claim 24 has been indicated to be allowable.

VII.

**ARGUMENT**

A. **Summary of Argument**

Appellant respectfully submits that in rejecting Claim 23 under 35 U.S.C. § 102(b), the Examiner has assumed that *Mason* discloses certain features that, in fact, are nowhere to be found in that reference. The essential basis for the Examiner's rejection is that the Mason drill barrel is "substantially open at its proximal end" as that limitation is used in Applicant's specification. The Examiner refers to Figure 1 of Mason in support of his position. However, when reviewing Figure 1 of Mason and the related specification, it is clearly depicted in Figure 1

and explicitly stated at column 2, lines 49 – 50, that hood 22 forms “an enclosed chamber about the entire operating mechanism of the machine” and that the hood, which is in the shape of the frustum of a cone, seals off the entire proximal end of Mason’s barrel. Thus, Mason’s apparatus is plainly not substantially open at its proximal end. In fact, the proximal end of Mason’s mechanism is entirely closed off.

It is not surprising that the Mason drill is not open at the proximal end because, unlike Applicant’s drill, it is not at all concerned with collecting cuttings that are blown upward around the outside of the barrel. At its proximal end, Mason’s apparatus has vent tube (32) which is attached directly to a hose (90), leaving no openings other than the small apertures (34) for venting gaseous dusts. See Fig. 1. Mason teaches vacuuming the cuttings up through the interior of the barrel and out through an attached hose (90). The hood 22 prevents material from falling into the barrel. According to Mason, “with this construction, any loose or surrounding material is prevented from falling or leaking into the operating parts of the machine.” Thus, Mason’s hood 22, disposed at the proximal end of the barrel, is designed for the stated purpose of preventing any excavation material from falling into the barrel. This is directly contrary to the teaching of Applicant’s invention, and in no way satisfies the requirement of claim 23 that the proximal end of the barrel be “substantially open.” In light of this description in Mason, how can his completely sealed barrel be considered to anticipate applicant’s claimed invention, which is “substantially open” at its proximal end for the very purpose of receiving and collecting cuttings from above the barrel?

The examiner appears to be interpreting “substantially open and substantially hollow at its proximal end” in a manner that is flatly inconsistent with the meaning imparted to that phrase by Applicant’s specification and drawings. The examiner asserts that Mason’s “suction means 66, 68, 70, stem 24 and vent tube 32” render Mason’s barrel substantially open at its proximal end. But the suction means 66, 68 and 70 are at the distal end (as defined by Applicant’s

specification) of Mason's barrel, not the proximal end. *See* Figs. 1 and 7. And stem 24 and vent tube 32 only permit egress of vacuumed cuttings from the barrel. The presence of these closed tubes does not render the barrel of Mason "substantially open" as that term is used by Applicant. Applicant's specification describes the barrel as "substantially" open" to the environment above the barrel, and more specifically as "substantially open" to receive and collect falling cuttings that have been ejected upward out of the shaft being drilled. *See* specification at p. 8, line 18 through p. 9, line 4; p. 14, lines 8 – 14; Fig. 4. Mason's barrel is completely sealed off to falling cuttings by hood 22, which has this express purpose. Stem 24 and vent tube 32 likewise seal off Mason's barrel from falling cuttings, and thus cannot be said to make an otherwise sealed barrel into one that is "substantially open" to falling cuttings.

As discussed above, Mason '130 fails to anticipate Applicant's claimed subject matter. Since the Examiner failed to interpret the claim language at issue in accordance with the specification, he failed to acknowledge or appreciate the clear differences between Applicant's claimed subject matter and Mason. Therefore, Applicant respectfully submits that this Board should overrule the Examiner's rejections.


## **VIII.**

### **CONCLUSION**

For the reasons set forth in detail above, it is respectfully submitted that the rejections of claims 23 and 25 under 35 U.S.C. 102(b) in view of Mason '130 are clearly and manifestly erroneous. Further, as shown above, the cited art generally does not teach or suggest a drilling apparatus substantially open in order to assist in excavation of shaft cuttings and other materials. Therefore, Appellant's claimed subject matter cannot be anticipated by the cited reference or the knowledge of the art generally.

For these reasons, Appellant respectfully requests reversal of the final rejection of claims 23 and 25 as outlined above.

Respectfully submitted,



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Date: 12-30-03

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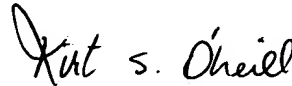
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#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 30, 2003.



Kirt S. O'Neill, Reg. No. 38,257